

REMARKS**Summary of the Office Action**

Claims 1-2 and 4-6 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over European Patent No. EP 059388 A2 to *Tanaka*.

Summary of the Response to the Office Action

Applicants traverse the rejection for at least the following reasons. Accordingly, claims 1-2 and 4-6 are pending for further consideration.

All Subject Matter Complies With 35 U.S.C. § 103(a)

Claims 1-2 and 4-6 are rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over *Tanaka*. Applicants respectfully traverse the rejection for the following reasons.

Applicants respectfully submit that the Office Action has not established a *prima facie* case of obviousness and therefore request that all rejections under 35 U.S.C. § 103(a) be withdrawn. To establish a *prima facie* case of obviousness, three basic criteria must be met (see MPEP §§ 2142-2143). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references must teach or suggest all the claim limitations.

First, the Office Action does not establish a *prima facie* case of obviousness at least because it has not identified any suggestion or motivation to combine the cited reference with knowledge generally available to one of ordinary skill in the art. Here, the suggestion or motivation to modify is not provided by either *Tanaka*, or by knowledge generally available to one of ordinary skill in the art, but only by impermissible hindsight. Therefore, it is respectfully

submitted that the statement in the Office Action the invention is obvious is not sufficient by itself to establish *prima facie* obviousness.

Second, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).” See MPEP § 2143.01. The Office Action does not provide any citation to suggest the desirability of modifying *Tanaka*. The mere assertion that *Tanaka* could be modified by what is ordinary skill in the art is not sufficient by itself to establish *prima facie* obviousness.

Third, Applicants respectfully submit that the Office Action has not established that the invention is unpatentable over *Tanaka* because each and every feature of Applicants’ claimed invention is not found in *Tanaka*. Namely, Applicants contend that independent claim 1 recites the features of “a cap-shape cover portion having a substantially closed end; and a packing protecting portion extending from a peripheral wall of an opening of said cover portion in a continual longitudinal direction, an inner surface of the cover portion includes a lip separating the packing protecting portion from the closed end of the cover portion, said packing protection portion having a cross-section perpendicular to the longitudinal direction that is further from the longitudinal axis than a cross-section of the cover portion.” Similarly, independent claim 5 recites the features of “a connector provided with a packing exposed around an outer peripheral portion of a rear end of said connector and . . . said packing having a cross-section perpendicular to the longitudinal direction that is greater than a cross-section of the connector along the same direction; a dustproof cover having a packing protecting portion extending from a peripheral wall of an opening of a cover portion in a continual longitudinal direction, wherein said

dustproof cover is fitted to said connector so as to cover the front portion and the outer peripheral portion of said connector with the cover portion, and said packing protecting portion covers said packing.” At least these features are not disclosed or taught by *Tanaka*.

Tanaka discloses a waterproof electrical connector that includes a housing inserted into a cavity defined in a counterpart of the connector and having a stepped portion on its rear portion such that an enlarged portion is provided by the stepped portion, an annular sealing member fitted with the housing is inserted into the cavity of the counterpart to abut the stepped portion for sealing a gap between the housing and an inner peripheral wall surface of the cavity. See the Abstract of *Tanaka*. However, the structure of *Tanaka* fails to teach or suggest at least the above-mentioned features of independent claims 1 and 5.

The Office Action states that *Tanaka* discloses all the features of claims 1 and 5. The Office Action subsequently identifies item 30 as the cover portion, item 22 as the packing protection portion of the cover portion, item 25b as the peripheral wall of an opening of the cover portion, and item 25c as the lip separating the packing protection portion from the closed end of the cover portion. Applicants respectfully submit that, contrary to the assertion that *Tanaka* teaches or suggests all the above-mentioned features, *Tanaka* does not teach or suggest the claimed features. See Figs. 1 and 2 of *Tanaka*. *Tanaka* actually teaches away from the present invention by teaching that the cover portion 30 does not include the packing protection portion 22, the lip 25c, or the peripheral wall opening 25b. Because *Tanaka* teaches these features, it cannot make obvious the invention recited in claims 1 and 5.

In other words, the Office Action admits that *Tanaka* teaches that the cover portion 30 is a separate and distinct item from the packing protection portion 22, the lip 25c, and the

peripheral wall opening 25b. This violates the ordinary meaning of the language of claim 1, which recites “a cap-shape cover portion having a substantially closed end; and a packing protecting portion extending from a peripheral wall of an opening of said cover portion in a continual longitudinal direction, an inner surface of the cover portion includes a lip separating the packing protecting portion from the closed end of the cover portion.” Here, the cover portion necessarily includes the lip and the packing protection portion. Similarly, for claim 5, “a dustproof cover having a packing protecting portion extending from a peripheral wall of an opening of a cover portion in a continual longitudinal direction,” requires that the cover portion include a packing protection portion. Thus, *Tanaka* fails to teach or suggest claims 1 and 5.

As pointed out in M.P.E.P. § 2143.03, “[t]o establish prima facie obviousness of a claimed invention, all the claimed limitations must be taught or suggested by the prior art”. *In re Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974). As such, Applicants respectfully assert that the third prong of *prima facie* obviousness has not been met. Therefore, Applicants respectfully request that the rejection under 35 U.S.C. § 103(a) should be withdrawn because *Tanaka* does not teach or suggest each and every feature of independent claims 1 and 5.

Additionally, Applicants respectfully submit that dependent claims 2-4 and 6 are also allowable insofar as they recite the patentable combinations of features recited in claims 1 and 5, as well as reciting additional features that further distinguish over the applied prior art.

CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of the Response, the Examiner is invited to contact the Applicants' undersigned representative to expedite prosecution.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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